

**REMARKS**

Claims 1- 16 and 18-20 are all the claims pending in the application.

Claim 15 has been amended to better conform it to US patent practice. The amendment is not intended to narrow the scope of the claim.

Claim 16 has been canceled without prejudice or disclaimer.

Applicant thanks the Examiner for allowing claims 1-8, 12-14, 18 and 19.

**35 U.S.C. § 101 Rejections**

The Examiner has rejected claims 15 and 16 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Claim 16 has been canceled. Applicant traverses the rejection of claim 15. The Examiner alleges that claim 15 is directed to a carrier wave, and thus, is non-statutory subject matter. Applicant respectfully disagrees. Claim 15 is directed to “A computer program product including computer-readable media with instructions to enable a computer to perform a method of recording/reproducing broadcasting signals.” There is no mention of a “carrier wave” in claim 15. Therefore, for at least these reasons, Applicant requests that the rejection of claim 15 be withdrawn.

**35 U.S.C. § 103 Rejections**

Claims 9-11 and 20 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Ando in view of Suenaga et al. (U.S. Patent No. 6,498,893). Applicant traverses these rejections because there is no motivation or suggestion to combine the references as suggested by the Examiner. The Examiner concedes that Ando fails to disclose or suggest at least the following limitations of claim 9:

supplies the recording files to the recording/reproducing manage unit to reproduce the recording files in response to a reproduction instruction; and is capable of supplying a first one of the recording files in parallel with recording a second one of the recording files, the first one having been recorded earlier than the second one.

In order to make up for this deficiency, the Examiner cites to Suenaga. However, the Examiner has failed to make a prima facie case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (emphasis added) MPEP 2143.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP 2143.01

The Examiner has failed to provide any suggestion or motivation as to why one skilled in the art would combine the teachings of Suenga with Ando to arrive at the claimed invention.

Therefore, the rejection must be withdrawn.

Regarding claims 10 and 11, they should be allowable at least based on their dependence from claim 9 for the reasons described above.

Claim 20 should also be allowable for reasons similar to those for claim 9.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the


AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. APPLN. NO.: 09/850,007

ATTY DOCKET NO.: Q64408

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Howard L. Bernstein  
Registration No. 25,665

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

Date: November 7, 2006